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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/605,687 | 10/17/2003 | Dean Willberg | 56.0758 | 2686 |
| 27452 | 7590 | 03/07/2007 | EXAMINER | |
| SCHLUMBERGER TECHNOLOGY CORPORATION | | | KUGEL, TIMOTHY J | |
| IP DEPT., WELL STIMULATION | | | ART UNIT | PAPER NUMBER |
| 110 SCHLUMBERGER DRIVE, MD1 | | | 1712 | |
| SUGAR LAND, TX 77478 | | | | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | NOTIFICATION DATE | DELIVERY MODE | |
| 3 MONTHS | | 03/07/2007 | ELECTRONIC | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/07/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/605,687 | WILLBERG ET AL. | |
| | Examiner Timothy J. Kugel | Art Unit 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 January 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,5,6,8-10,15 and 16 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,5,10,15 and 16 is/are rejected.
- 7) Claim(s) 6,8 and 9 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 December 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 5, 6, 8-10, 15 and 16 are pending as amended on 18 January 2007, claims 2-4, 7 and 11 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.
3. Applicant is thanked for pointing out the typographical error in the description of the teachings of US Patent 4,585,482 (Tice hereinafter), Tice teaches sodium chlorite—not sodium chloride—as the chlorine dioxide-liberating compound.

Response to Amendment

4. Applicant's amendment filed 18 January 2007, correcting a minor informality in claim 1 has been fully considered and is corrective.

The objection to claims 1, 5, 6, 8-10, 15 and 16 has been withdrawn.

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. Claims 1, 10 and 16 stand rejected under 35 USC 102(b) as being anticipated by US Patent 4,585,482 (Tice hereinafter).

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chlorite and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated

Art Unit: 1712

within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water (Abstract, Column 2 Lines 26-32 and 50-62, Column 3 Lines 3-29 and Column 4 Line 66 – Column 5 Line 17).

Regarding the limitation ‘An oilfield treatment composition’ in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the composition of Tice is capable of performing the intended use, it meets the claim.

6. Claim 5 stands rejected under 35 USC 102(b) as being anticipated by Tice as applied to claims 1, 10 and 16 above as evidenced by
<http://chemfinder.cambridgesoft.com/result.asp> for sodium chlorite, accessed 24 October 2006 (ChemFinder hereinafter).

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chlorite and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water as detailed above.

ChemFinder shows that sodium chlorite is soluble in water (Page 1).

7. Claim 15 stands rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tice.

Art Unit: 1712

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chlorite and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water as detailed above.

Since Tice teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the capability of the Tice composition to form a filter cake would inherently be the same as claimed.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102."

In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Response to Arguments

8. Applicant's arguments filed 18 January 2007 have been fully considered but they are not persuasive.

Applicant argues that, in teaching sodium chlorite, Tice fails to teach the solid acid-reactive material instantly claimed; however, Tice's teaching of sodium chlorite liberating chlorine dioxide in the presence of poly(lactic acid) reads on the instant claims. Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Allowable Subject Matter

9. Claims 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable—for the reasons of record—if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1712

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
Art Unit 1712



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